



UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Michael P. Tierney
Telephone: (703) 308-9797
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MAILED**AUG - 5 2002****PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Applicants: Watanabe et al.
Application No.: 09/120,383
Filed: 07/22/98
For: Sulfonated amino acid derivatives
and metalloproteinase inhibitors
containing the same

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,010.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).


Michael P. Tierney
Administrative Patent Judge

The opinion in support of the decision being
entered today is not binding precedent of the Board.

Paper 1

Filed by: Michael P. Tierney
Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
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Filed
August 5, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

FUMIHIKO WATANABE, HIROSHIGE TSUZUKI
AND MITSUAKI OHTANI
Junior Party
(U.S. Patent Application 09/120,383),

MAILED

AUG - 5 2002

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

v.

PATRICK MICHAEL O'BRIEN AND DRAGO ROBERT SLISKOVIC
Senior Party,
(U.S. Patent No. 5,756,545).

Patent Interference No. **105,010** (MPT)

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

Part B. Judge designated to handle the interference

Administrative Patent Judge Michael P. Tierney has been designated to handle the interference. 37 CFR § 1.610(a).

Part C. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

Part D. Conference call to set dates

A telephone conference call to set dates for taking action in the interference is scheduled for **10:30 a.m., October 2, 2002** (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. The parties involved in this interference are:

Junior Party

Named inventors: Fumihiko Watanabe, Kitakatsuragi-Gun, JP
Hiroshige Tsuzuki, Kyoto, JP
Mitsuaki Ohtani, Nara, JP

Application: U.S. Application No. 09/120,383, filed July 22, 1998

Title: Sulfonated Amino Acid Derivatives and Metalloproteinase
Inhibitors Containing the Same

Assignee: Shionogi & Co., Ltd.

Accorded Benefit: None¹

Attorneys: See last page

Address: See last page

¹Watanabe's Rule 608(b) statement is sufficient for the declaration of this interference. Yet, the statements contained in the Rule 607 and 608(b) statements fail to provide sufficient basis for according priority benefit to the earlier filed Japanese and PCT applications. Should Watanabe desire benefit of these applications, Watanabe may file a motion under Rule 633(f).

Senior Party

Named inventors: Patrick Michael O'Brien, Stockbridge, MI
Drago Robert Sliskovic, Saline MI

Patent: U.S. Patent No. 5,756,545, issued May 26, 1998, based upon U.S.
Application No. 08/844,598, filed April 21, 1997

Title: Biphenylsulfonamide Matrix Metal Allopeptinase Inhibitors

Assignee: Warner-Lambert Company

Accorded Benefit: None

Attorneys: See last page

Address: See last page

Part F. Count and claims of the parties

Count 1

A compound according to claim 1 of U.S. Patent No. 5,756,545.

Count 2

A method according to claim 14 of U.S. Patent No. 5,756,545.

The claims of the parties are:

O'Brien et al., U.S. Patent No. 5,756,545:	1-18
Watanabe et al., U.S. Application No. 09/120,383:	26-32

The claims of the parties that correspond to Count 1 are:

O'Brien et al., U.S. Patent No. 5,756,545:	1-13
Watanabe et al., U.S. Application No. 09/120,383:	26-31

The claims of the parties that **do not** correspond to Count 1 are:

O'Brien et al., U.S. Patent No. 5,756,545:	14-18
Watanabe et al., U.S. Application No. 09/120,383:	32

The claims of the parties that correspond to Count 2 are

O'Brien et al., U.S. Patent No. 5,756,545:	14-18
Watanabe et al., U.S. Application No. 09/120,383:	32

The claims of the parties that **do not** correspond to Count 2 are

O'Brien et al., U.S. Patent No. 5,756,545:	1-13
Watanabe et al., U.S. Application No. 09/120,383:	26-31

Part G. Heading to be used on papers

The following heading shall be used on papers filed in the interference. See § 18 of the
STANDING ORDER.

Paper _____²

Filed on behalf of [name of party]
By: Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

FUMIHIKO WATANABE, HIROSHIGE TSUZUKI
AND MITSUAKI OHTANI

Junior Party
(U.S. Patent Application 09/120,383),

v.

Patrick Michael O'Brien and Drago Robert Sliskovic
Senior Party,

(U.S. Patent No. 5,756,545).

Patent Interference No. 105,010 (MPT)

TITLE OF PAPER

² Leave a blank line because the board assigns the paper number.

Part H. Summary of dates for taking action

Times for taking action are set out in the following sections of the STANDING ORDER:

- i. § 7: date for identifying lead and backup counsel.
- ii. § 8: date for identifying any real party in interest.
- iii. § 9: date for requesting copies of involved and benefit applications and patents.
- iv. § 17: date for filing list of proposed preliminary motions.
- v. § 19: date for accomplishing certain discovery.
- vi. § 20: date for filing clean copy of claims.
- vii. § 21: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
- viii. § 23: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
- ix. § 33: date for objecting to admissibility of evidence.
- x. § 34: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
- xi. § 35: dates when cross-examination can take place.
- xii. § 45: dates for taking action with respect to settlement discussions

Part I. Order form for requesting file copies

FILE COPY REQUEST

Interference No. 105,010

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPO Deposit Account No. _____
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

Telephone, including area code: _____

Part J. Signature of administrative patent judge


MICHAEL P. TIERNEY
Administrative Patent Judge

Date: 8-5-02
Arlington, VA

Enc:³

Copy of STANDING ORDER

Copy of order used for setting times for taking action in the preliminary motion phase of the interference

Copy of order used for setting times for taking action in the testimony and briefing phases of the interference

Copy of O'Brien, U.S. Patent No. 5,756,545

Copy of claims 26-32 of Watanabe, U.S. Application 09/120,383.

³No Rule 690(b) or Form PTO-850 is enclosed.

cc (via Federal Express):

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